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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/522,714

01/28/2005

Makoto Nakagawa

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25944 7590 05/28/2008

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ALEXANDRIA, VA 22320-4850

EXAMINER

THROWER, LARRY W

ART UNIT

PAPER NUMBER

4111

MAIL DATE

DELIVERY MODE

05/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/522,714	Applicant(s) NAKAGAWA, MAKOTO	
	Examiner LARRY THROWER	Art Unit 4111	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 14-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-3 and 5-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/28/05; 11/7/2005</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- Group I, claim(s) 1-13, drawn to a hydrating case having a containment recess.
- Group II, claim(s) 14 and 16, drawn to a hydrating device employing a hydrating case having a containment recess.
- Group III, claim(s) 15, drawn to a hydrating device employing a hydrating case having a containment recess.
- Group IV, claim(s) 17-20, drawn to a moisture-containing contact lens hydrating method employing a hydrating case having a containment recess.

2. The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

- The common technical feature in all groups is the hydrating case having a containment recess for containing therein a moisture-containing contact lens and used for bringing the moisture-containing contact lens in a dry state into contact with a hydrating liquid within the containment recess in order to absorb water and swell, the hydrating case being characterized in that an area of a concave inside

face of the containment recess on which the moisture-containing contact lens rests is formed as a concave bowed face having a curvature generally equivalent to that of a front surface of the moisture-containing contact lens and a depression that opens out onto the concave bowed face being formed in order to create a gap between the moisture-containing contact lens and the containment recess so that when the hydrating liquid flows down along the concave inside face, the hydrating liquid enters the gap.

- This cannot be a special technical feature under PCT Rule 13.2, because the hydrating case is known in the prior art. Tsao (U.S. Patent No. 5,383,550) teaches a hydrating case (10; fig. 2) having a containment recess (14) for containing therein a moisture-containing contact lens (lens; fig. 3), which is capable of bringing the moisture-containing contact lens in a dry state into contact with a hydrating liquid within the containment recess (col. 2, lines 30-32), which is capable of allowing the contact lens to absorb water and swell. The hydrating case has an area of a concave inside face (22) of the containment recess (14) on which the moisture-containing contact lens is capable of resting. The concave inside face (22) is formed as a concave bowed face having a curvature generally equivalent to the front surface of the moisture-containing contact lens (fig. 3). The hydrating case also includes a depression (see marked-up illustration below) that opens out onto the concave bowed face which creates a gap between the moisture-containing contact lens (lens; fig. 3) and the

concave face (22; fig. 3) so that when the hydrating liquid flows down along the concave inside face, the hydrating liquid is capable of entering the gap.

3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

A. At least one groove is of a pattern extending generally in the circumferential direction of the concave bowed face; and

B. At least one groove has a pattern extending in the generally diametrical direction of the concave bowed face.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

4. The claims are deemed to correspond to the species listed above in the following manner:

Species A: Claims 1-4 and 6-13; and

Species B: Claims 1-3 and 5-13.

The following claim(s) are generic: Claim 1.

5. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Species A and B are directed to distinct features, where the patentability is based on divergent structural features. The differences between the species are significant to the extent that the species constitute prima facie patentably distinct combinations, absent evidence to the contrary. For this reason, it would be a serious burden for the examiner to consider both species since the search and examination for one of the species would not be required for the other species.

6. During a telephone conversation with Mario Constantino on May 22, 2008 a provisional election was made with traverse to prosecute the invention of Group 1, Species B, claims 1-3 and 5-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4 and 14-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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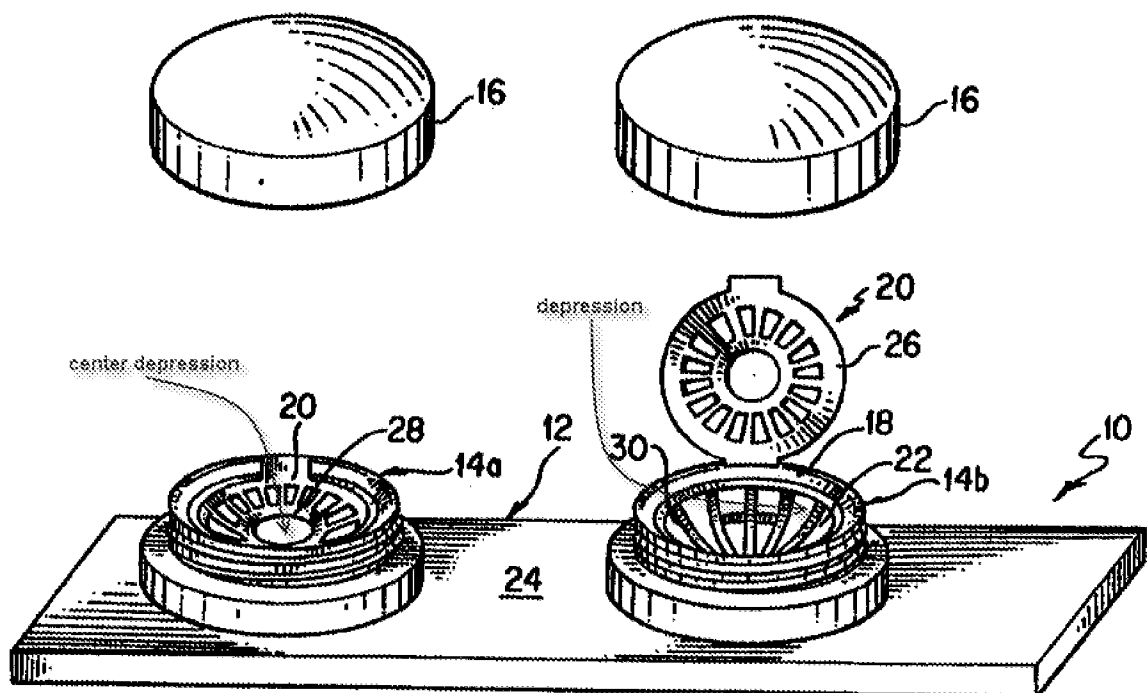
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3, 5, 8-11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsao (U.S. Patent No. 5,383,550).

- Regarding claim 1, Tsao teaches a hydrating case (10; fig. 2) having a containment recess (14) for containing therein a moisture-containing contact lens (lens; fig. 3), which is capable of bringing the moisture-containing contact lens in a dry state into contact with a hydrating liquid within the containment recess (col. 2, lines 30-32), which is capable of allowing the contact lens to absorb water and swell. The hydrating case has an area of a concave inside face (22) of the containment recess (14) on which the moisture-containing contact lens is capable of resting. The concave inside face (22) is formed as a concave bowed face having a curvature generally equivalent to the front surface of the moisture-containing contact lens (fig. 3). The hydrating case also includes a depression (see marked-up illustration below) that opens out onto the concave bowed face which creates a gap between the moisture-containing contact lens (lens; fig. 3) and the concave face (22; fig. 3) so that when the hydrating liquid flows down along the concave inside face, the hydrating liquid is capable of entering the gap.
- Regarding claim 2, Tsao discloses the depression (illustration below) that is formed in such a way that, when the moisture-containing contact lens is placed on the concave bowed face (22) of the containment recess (14), the gap formed between the moisture-containing contact lens and the containment recess has an opening

that opens to an outer peripheral side of the moisture-containing contact lens, and extends continuously diametrically inward from the opening (figs. 1 and 3).

- Regarding claim 3, Tsao discloses the depression being formed by at least one groove (figs. 1 and 3; col. 2, lines 59-65).



- Regarding claim 5, Tsao discloses the grooves forming a pattern extending in the diametrical direction of the concave bowed face (fig. 1).
- Regarding claim 8, as disclosed by Tsao in col 2, line 66 - col. 3, line 2, when the device of Tsao is used as a case, the lens can be placed on the basket (20) which is capable of functioning as a containment recess and covered with saline. Thus, a center having no grooves is formed in a center portion of the concave bowed face so

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that a center portion of the moisture-containing contact lens is superimposed over an entire face of the center portion. Support is capable of being provided by the ribs (30) on the underlying surface.

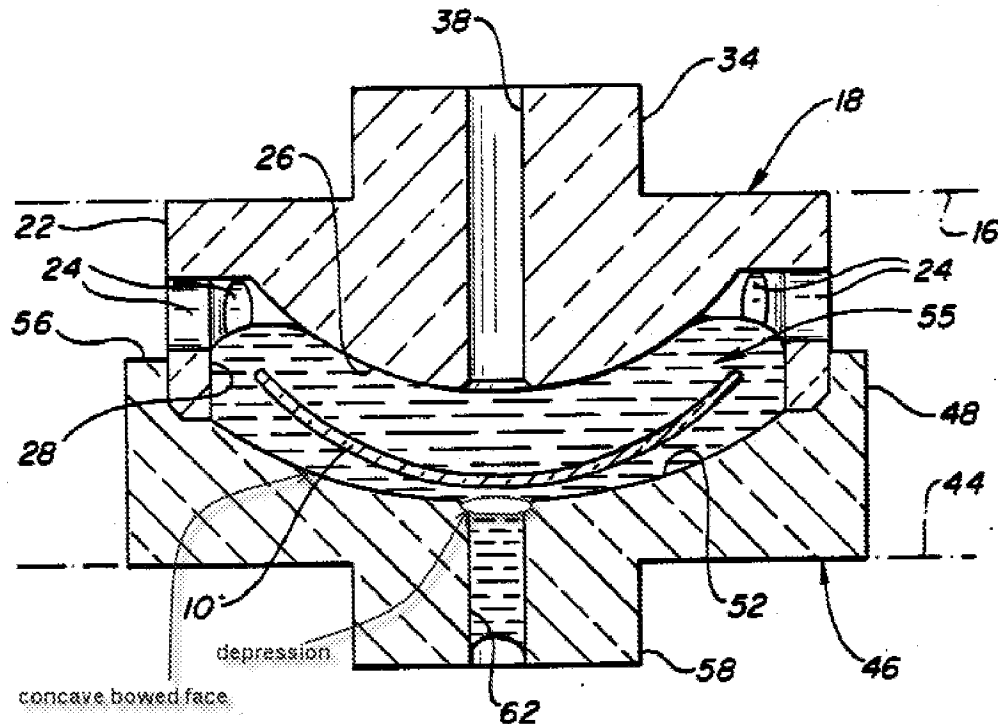
- Regarding claim 9, as disclosed by Tsao in col 2, line 66 - col. 3, line 2, when the device of Tsao is used as a case, the lens can be placed on the basket (20) which is capable of functioning as a containment recess and covered with saline. Thus, a center depression is formed in a center portion of the containment recess so that a lens center is capable of being supported floating above the containment recess by the center depression (see illustration below).
- Regarding claim 10, Tsao discloses both the concave bowed face and a bottom face of the depression having smooth, generally mirrored surfaces (fig. 3).
- Regarding claim 11, Tsao discloses a mating portion being formed in a rim (18) of a mouth of the containment recess, and a cover (16) being detachably attached by being mated with the mating portion (figs. 1-2; col. 2, lines 36-47).
- Regarding claim 13, Tsao discloses the mouth of the containment recess being provided with a liquid tight closure by the cover so as to constitute a distribution case in which the moisture-containing contact lens is sealed within the containment recess in a state of being immersed in a distribution storage liquid (figs. 1-2; col. 2, lines 36-47).

9. Claims 1, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Kindt-Larsen (U.S. Patent No. 5,080,839).

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- Regarding claim 1, Kindt-Larsen discloses a hydrating case (defined by carrier elements 18 and 46; fig. 5) having a containment recess (cavity 55) for containing therein a moisture-containing contact lens (10), which is capable of bringing the moisture-containing contact lens in a dry state into contact with a hydrating liquid within the containment recess (liquid within cavity 55; col. 7, line 25 - col. 8, line 2), which is capable of allowing the contact lens to absorb water and swell. The hydrating case has an area of a concave inside face (52) of the containment recess (55) on which the moisture-containing contact lens is capable of resting. The concave inside face (52) is formed as a concave bowed face having a curvature generally equivalent to the front surface of the moisture-containing contact lens (10). The hydrating case also includes a depression (see marked-up illustration below) that opens out onto the concave bowed face which creates a gap between the moisture-containing contact lens (10) and the concave face (52) so that when the hydrating liquid flows down along the concave inside face, the hydrating liquid is capable of entering the gap.
- Regarding claim 9, Kindt-Larsen discloses a center depression being formed in a center portion of the containment recess so that a lens center is supported floating

above the containment recess by the center depression (see illustration below).



- Regarding claim 11, Kindt-Larsen teaches a mating portion being formed in a rim of a mouth of the containment recess (figs. 4-5), and a cover (18; fig. 4) is detachably attached by being mated to the mating portion (fig. 5).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsao (U.S. Patent No. 5,383,550) as applied to claim 1 above.

- Tsao teaches a hydrating case (10; fig. 2) having a containment recess (14) for containing therein a moisture-containing contact lens (lens; fig. 3), which is capable of bringing the moisture-containing contact lens in a dry state into contact with a hydrating liquid within the containment recess (col. 2, lines 30-32), which is capable of allowing the contact lens to absorb water and swell. The hydrating case has an area of a concave inside face (22) of the containment recess (14) on which the moisture-containing contact lens is capable of resting. The concave inside face (22) is formed as a concave bowed face having a curvature generally equivalent to the front surface of the moisture-containing contact lens (fig. 3). The hydrating case also includes a depression (see marked-up illustration above) that opens out onto the concave bowed face which creates a gap between the moisture-containing contact lens (lens; fig. 3) and the concave face (22; fig. 3) so that when the hydrating liquid flows down along the concave inside face, the hydrating liquid is capable of entering the gap.

- Tsao fails to disclose the specific groove depth dimensions and area depression ratios of claims 6-7. However, absent a showing of unexpected benefit, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have determined, by routine experimentation, suitable groove dimensions to allow the lens to rest upon and provide adequate hydration and circulation of fluid to the lens as suggested by Tsao in col. 1, lines 63-65.

13. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kindt-Larsen (U.S. Patent No. 5,080,839) as applied to claim 1 above.

- Kindt-Larsen discloses a hydrating case (defined by carrier elements 18 and 46; fig. 5) having a containment recess (cavity 55) for containing therein a moisture-containing contact lens (10), which is capable of bringing the moisture-containing contact lens in a dry state into contact with a hydrating liquid within the containment recess (liquid within cavity 55; col. 7, line 25 - col. 8, line 2), which is capable of allowing the contact lens to absorb water and swell. The hydrating case has an area of a concave inside face (52) of the containment recess (55) on which the moisture-containing contact lens is capable of resting. The concave inside face (52) is formed as a concave bowed face having a curvature generally equivalent to the front surface of the moisture-containing contact lens (10). The hydrating case also includes a depression (see marked-up illustration below) that opens out onto the concave bowed face which creates a gap between the moisture-containing contact lens (10) and the concave face (52) so that when the

hydrating liquid flows down along the concave inside face, the hydrating liquid is capable of entering the gap. Kindt-Larsen teaches a mating portion being formed in a rim of a mouth of the containment recess (figs. 4-5), and a cover (18; fig. 4) is detachably attached by being mated to the mating portion (fig. 5). The cover (18) has a tube through-hole (38) formed therein for supplying hydrating liquid to the lens.

- Kindt-Larsen fails to disclose a supply tube for supplying the hydrating liquid to the containment recess being inserted through the tube through-hole. However, as noted above, Kindt-Larsen discloses a tube through-hole which allows the hydrating liquid to be delivered to the containment recess for hydrating the lens. Whether or not the fluid is delivered directly through the through-hole, or delivered through a supply tube inserted into the through-hole, the result would be the same. Therefore, it would have been obvious at the time the invention was made to have modified the lens hydrating device of Kindt-Larsen with a supply tube to be inserted through the through-hole to deliver the hydrating liquid, because the result of hydrating the contact lens would be the same.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LARRY THROWER whose telephone number is (571)270-5517. The examiner can normally be reached on Monday through Thursday from 7:30AM-5PM est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam C. Yao can be reached on 571-272-1224. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Larry Thrower/
Examiner, Art Unit 4111

/Sam Chuan C. Yao/
Supervisory Patent Examiner, Art Unit 4111